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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicant:

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Serial No.: 09/514,978

For: PROCESSING TRUSTED COMMANDS IN TRUSTED AND UNTRUSTED ENVIRONMENTS

Art Unit: 2755

Examiner: Unknown

Docket No.: C99020US

INFORMATION DISCLOSURE STATEMENT

Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

FEDERAL CIRCUIT DECISION

Attached is a recent Federal Circuit decision, *In re Zurko*, ---F.3d---, 2001 WL 869324, 59 U.S.P.Q.2d 1693 (Fed. Cir. August 2, 2001)(No. 96-1258, 07/479,666), in the parent case (Serial No. 07/479,666) that may be of interest to the examiner. The decision was favorable to the Applicants. Briefly, the Federal Circuit reversed the Board of Patent Appeals and Interferences' rejection of claims 1, 4 and 5 under 35 U.S.C. § 103(a) based on the UNIX operating system, as described in Applicants' information disclosure statement of February 13, 1990 in the parent case, and Dunford, FILER Version 2.2 ("Dunford"), also described in Applicants' information disclosure statement of February 13, 1990 in the parent case. The Federal Circuit ruled that the Board's conclusion of

obviousness was based on a misreading of the references relied upon and, therefore, lacked substantial evidence support.

The decision has a bearing on the present case in that claims 38-41 of this divisional case correspond to the non-elected claims 6-9 from the parent case. While these non-elected claims were not part of the appeal, prior to the restriction requirement in the Office Action of July 21, 1993, claims 6-9, like claims 1 and 4-5 which were part of the appeal, were rejected under 35 U.S.C. § 103(a) based on the UNIX operating system and Dunford. The Office Action of July 21, 1993 treated claims 1 and 4-5 (Group I) and claims 6-9 (Group II) as subcombinations. In view of the Federal Circuit decision, Applicants submit that the Patent Office may be estopped from rejecting claims 38-41 based on a combination of the UNIX operating system and Dunford. *See Pfaff v. Wells Electronics*, 5 F.3d 514, 518 (Fed. Cir. 1993)(interpretation of claim necessary to judgment of non-infringement had an issue preclusive effect in a later infringement suit against the same accused infringer based on subsequently developed products). In other words, the Patent Office cannot revisit the identical issues adjudicated by the Federal Circuit.

CITED REFERENCES

Applicants hereby submit the following references in accordance with 37 C.F.R. §§ 1.56 and 1.97. Copies of the references cited in the attached PTO-1449 are found in the parent application of this case, serial number 07/479,666, filed February 13, 1990.

No fee is required because, under 37 C.F.R. § 1.97(b), this Information Disclosure Statement is being filed (1) within three months of this application's filing date, (2) within three months of entry into the national phase under 37 C.F.R. § 1.491 of an international application, or (3) before the mailing date of the first office action on the merits.

Respectfully submitted,

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Date: 9/12/01

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Assistant Commissioner for Patents, Washington, D.C. 20231 on 9/12, 2001.

George W. Jordan III, Reg. No. 41,880